

ESTTA Tracking number: **ESTTA699011**Filing date: **09/29/2015**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**Petition for Cancellation**

Notice is hereby given that the following parties request to cancel indicated registration.

**Petitioner Information**

Name	Anom Suheri		
Entity	Individual	Citizenship	INDONESIA
Address	Komp Pelangi Regency C.6 RT 05 RW 01 Ampang Padang, INDONESIA		

Name	Anthony Marcotti		
Entity	Individual	Citizenship	UNITED STATES
Address	629 Camino de los Mares #101 San Clemente, CA 92673 UNITED STATES		

Name	Raymond Wilcoxon		
Entity	Individual	Citizenship	UNITED STATES
Address	Komp Pelangi Regency C.6 RT 05 RW 01 Ampang Padang, INDONESIA		

Name	D3 Holdings, LLC		
Entity	Limited Liability Company	Citizenship	Delaware
Address	134 Indian Head Road Riverside, CT 06878 UNITED STATES		

Attorney information	Joshua Richman 4445 Eastgate Mall, Suite 200 San Diego, CA 92121 UNITED STATES litigation@ipla.com		
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**Registrations Subject to Cancellation**

Registration No	4078032	Registration date	12/27/2011
Registrant	RAIHANA HEUER P.T. KANDUI BEACH VILLAS PADANG WESTERN SUMATRA, 25000 INDONESIA		

**Goods/Services Subject to Cancellation**

Class 043. First Use: 2004/01/15 First Use In Commerce: 2006/10/20

All goods and services in the class are cancelled, namely: Health resort services, namely, providing food and lodging that specialize in promoting patrons' general health and well-being; Resort hotels;

Resort lodging services
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## Grounds for Cancellation

<i>Torres v. Cantine Torresella S.r.l.Fraud</i>		808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)	
Priority and likelihood of confusion		Trademark Act section 2(d)	
Other		Respondent was not the correct applicant at the time she applied for the Registrations and therefore the Registrations should be declared void ab initio	
Registration No	4052051	Registration date	11/08/2011
Registrant	RAIHANA HEUER P.T. KANDUI BEACH VILLAS WESTERN SUMATRA, 25000 INDONESIA		

## Goods/Services Subject to Cancellation

Class 043. First Use: 2010/12/01 First Use In Commerce: 2010/12/01 All goods and services in the class are cancelled, namely: Resort lodging services
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## Grounds for Cancellation

<i>Torres v. Cantine Torresella S.r.l.Fraud</i>		808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)	
Priority and likelihood of confusion		Trademark Act section 2(d)	
Other		Respondent was not the correct applicant at the time she applied for the Registrations and therefore the Registrations should be declared void ab initio	
Registration No	4717526	Registration date	04/07/2015
Registrant	RAIHANA HEUER P.T. KANDUI BEACH VILLAS PADANG WESTERN SUMATRA, 25000 INDONESIA		

## Goods/Services Subject to Cancellation

Class 025. First Use: 2015/01/20 First Use In Commerce: 2015/01/20 All goods and services in the class are cancelled, namely: Clothing, namely, T-shirts, shirts, pants, shorts, sweatshirts, hooded sweatshirts, headwear, hats, jackets, footwear, flip flops, tank tops, swimsuits, tops, bottoms
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## Grounds for Cancellation

<i>Torres v. Cantine Torresella S.r.l.Fraud</i>		808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)	
Priority and likelihood of confusion		Trademark Act section 2(d)	
Other		Respondent was not the correct applicant at the time she applied for the Registrations and therefore the Registrations should be declared void ab initio	

## Marks Cited by Petitioner as Basis for Cancellation

U.S. Application/ Registra-	NONE	Application Date	NONE
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tion No.			
Registration Date	NONE		
Word Mark	KANDUI		
Goods/Services	Resort lodging services, dining and bar services, boat charter services, clothing, souvenirs, gift shop services, photography services, video services, travel planning services		

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	KANDUI RESORT		
Goods/Services	Resort lodging services, dining and bar services, boat charter services, clothing, souvenirs, gift shop services, photography services, video services, travel planning services		

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Design Mark	 <p>The logo for KANDUI RESORT features the words "KANDUI RESORT" in a large, bold, serif font. Below this, a horizontal line separates the name from the location "MENTAWAI ISLANDS, INDONESIA", which is written in a smaller, all-caps, serif font.</p>		
Goods/Services	Resort lodging services, dining and bar services, boat charter services, clothing, souvenirs, gift shop services, photography services, video services, travel planning services		

Attachments	kandui.jpg Petition for Cancellation.pdf(266163 bytes )
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## Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Joshua J. Richman/
Name	Joshua Richman
Date	09/29/2015

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**  
**BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Anom Suheri; Raymond Wilcoxon; Anthony Marcotti; and D3 Holdings, LLC, a Delaware limited liability company,	)	
	)	Petition No. _____
Petitioners,	)	Mark: <b>KANDUI</b>
	)	Registration No.: <u>4078032</u>
	)	Filing Date: December 7, 2010
	)	Registration Date: December 27, 2011
v.	)	
	)	Mark: <b>KANDUI VILLAS</b>
Raihana Heuer,	)	Registration No.: <u>4052051</u>
	)	Filing Date: December 31, 2010
Respondent.	)	Registration Date: November 8, 2011
	)	
	)	Mark: <b>KANDUI</b>
	)	Registration No.: <u>4717526</u>
	)	Filing Date: December 10, 2013
	)	Registration Date: April 7, 2015
	)	
	)	

**CONSOLIDATED PETITION FOR CANCELLATION**

Petitioners Anom Suheri, Raymond Wilcoxon, Anthony Marcotti and D3 Holdings, LLC, a Delaware limited liability company (together, the “**Petitioners**”), bring this petition to cancel United States Federal Registration Nos. 4078032, 4052051 and 4717526 comprising or containing the mark KANDUI, applied for and obtained by Raihana Heuer (the “**Respondent**”), on the grounds that they have suffered damage and will continue to suffer damage because of the registrations. Petitioners allege the following as grounds for cancellation:

**Background**

1. In 2004, a group of individuals comprised of Anom Suheri, Anthony Marcotti, Raymond Wilcoxon, Amen McDonald, Johnny Ocean, Jordan Heuer and Respondent (each

individually a “**Founder**”, and together, the “**Founders**”) associated together and started a surfing resort on a small island called Karangmajat Island in the Indian Ocean, 100 miles off the western coast of Sumatra, Indonesia. Karangmajat Island is located in the remote archipelago known as the Mentawai Islands, a region world famous for perfect surfing waves.

2. The Founders agreed that the name of the surfing resort would be Kandui Resort.

3. On July 5, 2005, Mr. Marcotti, on behalf of the Founders, registered the domain name [www.KanduiResort.com](http://www.KanduiResort.com) (the “**Domain**”), for use in promoting and marketing Kandui Resort. Content relating to Kandui Resort was first published on the Domain in 2005.

4. On April 9, 2006, Kandui Resort welcomed its first group of paid guests – all of whom were from the United States. Since at least as early as April 9, 2006, the Founders (or their respective successors) have continuously used KANDUI and KANDUI RESORT in United States commerce in connection with resort lodging services, dining and bar services, boat charter services, travel planning services, and related services.

5. Starting at least as early as 2008, Kandui Resort began selling clothing and other souvenirs in a gift shop on Karangmajat Island and also began offering photography and video services to guests to document their surfing vacations. Since at least as early as 2008, the Founders (or their respective successors) have continuously used KANDUI and KANDUI RESORT in United States commerce in connection with the sale of clothing, souvenirs, a retail gift shop and photography and video services.

6. After Kandui Resort opened, it quickly became one of the most famous and recognizable surfing resorts in the world, regularly hosting the world’s best surfers as well as celebrities and, as a result, has drawn significant media attention in surfing magazines, movies, websites and blogs.

7. Over the years, Kandui Resort has been widely advertised in print and online publications directed to United States consumers, including [www.Surflin.com](http://www.Surflin.com) (based in the United States), [www.StormSurf.com](http://www.StormSurf.com) (based in the United States), [www.SurferMag.com](http://www.SurferMag.com) (based in the United States), [www.TransworldSurf.com](http://www.TransworldSurf.com) (based in the United States), [www.CoastalWatch.com](http://www.CoastalWatch.com) (based in Australia), [www.BaliWaves.com](http://www.BaliWaves.com) (based in Indonesia) and [www.MagicSeaweed.com](http://www.MagicSeaweed.com) (based in United Kingdom).

8. Since Kandui Resort first opened, the majority of its revenue has been from guests visiting from the United States and all of its bookings have been made in California.

9. Kandui Resort owns and maintains social media accounts on Facebook®, Twitter® and Instagram® that together have over 25,000 followers.

#### **Respondent's Bad Acts**

10. Several years after Kandui Resort opened, Respondent and her husband Jordan Heuer (two of the Founders) broke off and opened a competing surfing resort on the same small island. They named their resort Kandui Villas.

11. On information and belief, Kandui Villas first opened for business in 2010.

12. Soon after opening, and knowing that the Founders had not previously applied to register KANDUI or KANDUI RESORT, Respondent applied to register the following marks with the USPTO in her individual capacity, without prior notice or agreement from the other Kandui Resort Founders (or their respective successors):

Mark	Filing Date	Publication Date	Registration Date	Class/Goods
KANDUI Reg. No. <a href="#">4078032</a>	12/07/2010	08/23/2011	12/27/2011	Class 43: Health resort services, namely, providing food and lodging that specialize in promoting patrons' general health and well-being; Resort hotels;



				Resort lodging services
<b>KANDUI VILLAS</b> Reg. No. <a href="#">4052051</a>	12/31/2010	08/23/2011	11/08/2011	Class 43: Resort lodging services
<b>KANDUI</b> Reg. No. <a href="#">4717526</a>	12/10/2013	05/27/2014	04/07/2015	Class 25: Clothing, namely, T-shirts, shirts, pants, shorts, sweatshirts, hooded sweatshirts, headwear, hats, jackets, footwear, flip flops, tank tops, swimsuits, tops, bottoms

(each individually a “**Registration**” and together, the “**Registrations**”).<sup>1</sup>

13. On information and belief, on September 12, 2007, Respondent registered the domain [www.KanduiVillas.com](#). On information and belief, content was first published on the domain in 2010 to promote and market the competing Kandui Villas as an alternative to Kandui Resort.

14. Kandui Villas promotes its resort in the same or highly similar channels as Kandui Resort, and markets to United States citizens. Like Kandui Resort, Kandui Villas also owns and maintains social media accounts on Facebook®, Twitter® and Instagram®.

15. Respondent has adopted font and logo stylization for Kandui Villas that is almost identical to the font and logo stylization that the Founders have used for Kandui Resort for years. Below is a side-by-side comparison of the respective logos:

Petitioners	Respondent
	

<sup>1</sup> Though not at issue in this proceeding, it is noteworthy that in 2010, Respondent also applied to register KANDUI VILLAS in Indonesia.



On information and belief, Respondent adopted this near identical font and stylization in order to confuse and mislead consumers into believing the resorts are related or affiliated.

16. Respondent has taken copyrighted content from Kandui Resort's website and published it on its own website. The copyright violations were eventually remedied through DMCA take-down notices sent to the domain registrars.

17. Substantial evidence of actual marketplace confusion between KANDUI RESORT and KANDUI VILLAS exists. Guests from both Kandui Resort and Kandui Villas are frequently confused as to whether an association exists between the two resorts.

18. Respondent's adoption and use of KANDUI VILLAS as the name of a rival resort located on the same small island has caused damage to Petitioners and Kandui Resort. Respondent and her husband Jordan Heuer have intentionally marketed Kandui Villas in ways that have drawn a direct association with Kandui Resort in order to palm off goodwill owned by Kandui Resort and to lure guests to their competing resort to the detriment of Kandui Resort.

### **Standing**

19. Petitioners Anom Suheri, Anthony Marcotti and Raymond Wilcoxon have direct and personal stakes in the outcome of this proceeding because they are among the Founders of Kandui Resort and therefore common law rights in the KANDUI and KANDUI RESORT marks accrue to them.

20. Petitioner D3 Holdings, LLC is successor in interest to Founder Johnny Ocean and therefore has a direct and personal stake in the outcome of this proceeding because it steps into the shoes of Founder Johnny Ocean who owned common law rights in the KANDUI and KANDUI RESORT marks.

21. Petitioners have not consented to Respondent's registration of KANDUI or KANDUI VILLAS; have not licensed or otherwise acknowledged that Respondent owns the KANDUI or KANDUI VILLAS marks; and have not assigned Respondent rights in or to the KANDUI or KANDUI VILLAS marks.

### **Grounds for Cancellation**

22. In each of Respondent's trademark applications, Respondent declared under oath that she was the rightful owner of the respective trademarks and that she had no knowledge of any "other person, firm, corporation, or association [with] the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely... to cause confusion, or to cause mistake, or to deceive". Lanham Act § 1 (15 USC § 1051). At the time the applications were filed, Respondent knew that she was not the rightful owner of the KANDUI mark, and knew that adopting KANDUI VILLAS would likely cause confusion, mistake or would deceive consumers. Therefore, Respondent made a false representation to the USPTO with the intent to deceive the USPTO.<sup>2</sup> For this reason, the Registrations should be cancelled.

23. Respondent is not, and was not at the time she filed the applications, the rightful owner of the KANDUI mark. For this reason, the Registrations should be declared *void ab initio* and cancelled.

24. The KANDUI and KANDUI RESORT marks were first used in United States commerce by the Founders years before Respondent applied for the Registrations or used KANDUI or KANDUI VILLAS. Respondent's KANDUI and KANDUI VILLAS marks so resemble Petitioners' KANDUI and KANDUI RESORT marks in sight, sound, meaning and

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<sup>2</sup> All three applications were signed by Respondent's attorney. 37 CFR § 2.33.

commercial impression, as to be likely, when applied to the goods and services claimed in the Registrations, to cause confusion or mistake or to deceive, or to create the false impression that Respondent's goods and services are provided by, related to, endorsed by, or associated with Petitioners, or otherwise cause injury to Petitioners' rights in their KANDUI and KANDUI RESORT marks, in violation of Lanham Act §2(d) (15 U.S.C. §1052(d)), with consequent damage to Petitioners and the public. Because Petitioners have senior rights to KANDUI and KANDUI RESORT, and because there is a likelihood of confusion, the Registrations should be cancelled.

WHEREFORE, it is respectfully requested that this Consolidated Petition for Cancellation be sustained and that Respondent's Registrations be cancelled.

Dated: September 29, 2015

Respectfully submitted,

/Joshua J. Richman/

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*Attorneys for Petitioners*

**CERTIFICATE OF SERVICE**

I hereby certify that the foregoing document was served upon Respondent on September 29, 2015, by mailing a copy thereof via first-class U.S. mail, postage pre-paid to the following correspondent addresses of record for Respondent:

For Registration Nos. 4078032 (KANDUI) and 4052051 (KANDUI VILLAS)

RAIHANA HEUER  
P.T. KANDUI BEACH VILLAS  
POLAMAS BLOK L # 3  
PADANG WESTERN SUMATRA 25000  
INDONESIA

For Registration No. 4717526 (KANDUI)

TODD WINTER  
WINTER LLP  
1901 NEWPORT BLVD STE 350  
COSTA MESA, CALIFORNIA 92627-2299  
UNITED STATES

Dated: September 29, 2015

*/Amanda Costa/*

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Amanda Costa